

REMARKS

Claims 1-19 are pending in this application. The Examiner has withdrawn claims 10 and 11 from examination as allegedly being drawn to a non-elected species. By this amendment, applicants have amended the claim 1 to more clearly define the invention, amended claim 4 to be dependent from claim 1, and canceled claims 3, 10, and 11. Applicants respectfully request entry of the above-amendments. Upon entry, claims 1-2, 4-9, and 12-19 will be pending in the subject application.

Rejection Under 35 U.S.C. 103

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1-9 and 12-19 under 35 U.S.C. 103(a) as allegedly being obvious over U.S. Patent No. 5,611,153 (Fisher et al.) in view of U.S. Patent No. D389,296 (Sessa). The examiner contends that Fischer teaches an insole comprising a top cover and a lower layer made of a viscoelastic gel substantially as claimed except for a recess having spring walls formed in a generally sinusoidal wave shape. The examiner asserts that Sessa teaches an insole wherein the lower surface has a sinusoidal wave shape in a recess in the heel portion and the toe portion. The examiner concludes that it would have been obvious to one of ordinary skill in the art to provide the insole of Fisher with a generally sinusoidal wave shape, to provide better ventilation. With regard to claim 14, the examiner states that official notice is taken that the claimed feature is old and conventional in the art to provide pattern trim lines at the toe portion for trimming the insole to fit into smaller size footware. The examiner concludes that it would have been obvious to provide the insole as taught above with pattern trim lines in the toe portion to facilitate trimming the insole to the desired size.

In response, but without conceding the correctness of the examiner's position, applicants have amended claim 1 to more clearly claim the invention at issue in this application, namely the species of insole having only spring walls with a sinusoidal wave pattern. Support for the amendment to claim 1 can be found, for example, in Figures 2 and 7, where the spring walls formed in the recess(es) of the claimed insole have only a generally sinusoidal pattern. While not conceding that one of ordinary skill in the art would have combined the teachings of the references as the examiner has, without reference to the subject specification, applicants maintain that an insole with only sinusoidal spring wall members is clearly not disclosed or suggested in either Fischer or Sessa. Nothing in either reference teaches or suggests the spring effect versus damping effect described in the subject specification (see, e.g., page 8, line 9, to page 9, line 19) which is embodied in the claimed insole consisting of the generally sinusoidal spring walls.

With respect to the examiner's comments regarding claim 14, applicants understand the examiner to be referring to claim 15. Without conceding the correctness of the examiner's position, applicants maintain that as claim 15 is dependent from claim 1, claim 15 is patentable for the same reasons as discussed above.

Therefore, applicants maintain that the combination of the teachings of the cited references would not render the claimed invention obvious under 35 U.S.C. 103 and respectfully request that the rejection be withdrawn.

Rejection for Double Patenting

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1-9 and 12-19 on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of U.S. Patent No. 6,598,321, which issued from a parent of the subject application.

In response, in an earnest effort to move this application to allowance and without conceding the correctness of the examiner's position, applicants submit with this paper a Terminal Disclaimer executed by the undersigned on behalf of the assignee of the subject application and U.S. Patent No. 6,598,321, Schering-Plough Healthcare Products, Inc.

CONCLUSION

In summary, applicants maintain that the subject application is now in condition for allowance and a Notice of Allowance is therefore respectfully requested. If the undersigned can be of assistance in advancing the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,



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